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B | of the participant previously depicted in the static picture.

14. Method according to claim 1, wherein the static video images each depict a different person.

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**REMARKS**

This Amendment is submitted in response to the Office Action mailed on October 23, 2000. Claims 1 - 10 are pending, and all stand rejected at present. Claims 11 -14 are added. Support for the added claims is found in the Specification in the paragraph on page 10, immediately preceding the heading "Additional Considerations," and at other locations.

**Response to Anticipation Rejections**

Claim 2, and its dependant claims 5, 6, 8, and 10, were rejected on grounds of anticipation, based on Dagdeviren. Claim 2 recites:

2. A method of establishing an audio-video conference, comprising the following steps:

- a) setting up an audio-video conference on a high-bandwidth communication channel;
- b) during the setting-up step, holding an audio conference using a POTS channel; and

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c) after setting up completes

i) holding the audio-video conference on the high-bandwidth channel; and

ii) terminating the audio conference on the POTS channel.

Applicant points out that claim 2(b) recites "holding an audio conference using a POTS channel" "during the setting-up step" of 2(a). The only POTS lines shown in Dagdeviren are lines 102, 106, 122, and 126 in his Figure 1. However, Applicant cannot locate (1) a discussion of those lines, nor (2) a discussion stating that an audio conference is held using those lines during any setting-up step. Therefore, Applicant requests, under 37 CFR §§ 1.104(b) and 1.106(b) and 35 U.S.C. § 132, that the PTO specifically identify claim 2(b) in Dagdeviren, together with the "setting-up" step of 2(a).

It appears that the PTO is relying on "voice grade calls" mentioned by Dagdeviren, such as in column 4, line 54, and column 5, top, and line 55. However, those calls are not POTS calls. They are voice calls, but carried by the B-channel of an ISDN line. (Column 5, lines 53 - 59.) They are digital voice calls. Those calls may carry voice information, but the signals carrying the voice information are digital. (Column 5, bottom.)

To explain this further, Applicant points out that Dagdeviren's Figure 2 shows one of his ISDN video phones. (Column

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5, line 53.) The only voice information reaching B CHANNEL 1 or B CHANNEL 2 must pass through PCM CODEC 202 or AUDIO CODEC 207. But a "codec" is a device which converts analog signals into digital, and vice-versa. (The undersigned attorney believes that the term "codec" is an acronym for "code/decode.") Thus, the B CHANNELS carry digital signals, into which voice information has been inserted.

Restated, EARPHONE 205 in Dagdeviren's Figure 2 receives analog signals. (Column 5, line 68 - column 6, line 2. "EARPHONE" refers to the small speaker in the handset of his videophones. The lead-line of call-out 127 in his Figure 2 touches a handset.) EARPHONE 205 receives them from PCM CODEC 202, which receives digital signals from line 201, namely B CHANNEL 1. (Column 5, bottom.) A similar point applies to MOUTHPIECE 208.

Therefore, Applicant submits that (1) Dagdeviren does not discuss a POTS call as in claim 2(b), nor (2) holding a POTS call during any set-up step. Applicant offers to submit an affidavit on these points, if the Examiner so requests.

Dagdeviren shows a voice-grade call, but carried by **digital signals**, on ISDN channels. He specifically states that he uses "an ISDN audio . . . call . . . carried over a . . . digital loop." (Column 2, lines 62 - 66.)

In further support of this conclusion, Applicant points out

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that the acronym "POTS" refers to "Plain Old Telephone Service." (Dagdeviren, column 1, lines 21, 22.) The operations cited by the PTO as showing claim 2(b) would not be possible in, for example, 1960: ISDN lines did not exist at that time. Thus, since Dagdeviren requires ISDN lines to perform his operations, he cannot be said to use a POTS channel, as in claim 2(b), because he could not operate in 1960.

Applicant points out that it is axiomatic that, for anticipation to occur, the anticipating reference must infringe the claim in question. Dagdeviren does not infringe claim 2.

This applies to the dependent claims of claim 2.

#### **Response to Obviousness-Rejections**

##### No Valid Teaching for Combining References

Claims 1, 3, 4, 7, and 9 were rejected as obvious, based on Dagdeviren and Partridge. However, MPEP § 2145(j)(3) states:

As discussed in MPEP § 2143.01, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings.

No such suggestion or motivation has been given for combining the references.

The rationale given is the following:

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[It is obvious] to modify Dagdeviren's system to . . . [display] static visual images during the audio only conference as this would enable call screening based upon calling party's image as taught by Partridge.

(Office Action, page 3, second paragraph.)

However, Applicant submits that several problems exist in this rationale.

First Problem: Both References not needed  
To Attain Call Screening

One is that the goal of the rationale is to "enable call screening." However, Partridge, **by himself** attains call screening using static video images. There is no reason to add Dagdeviren.

Stated another way, the **addition** of Dagdeviren does not produce the call screening which is sought. Thus, the goal of attaining call screening is not reached by the **combination** of references. It is reached by Partridge alone.

Therefore, the rationale proposed by the PTO does not lead to combining the references.

Second Problem: Combination Modifies Reference

A second problem is that the combination of references modifies the operation of Dagdeviren. Dagdeviren states that a **digital voice call** is placed first. Then, a video call is set up,

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if the parties have the proper equipment, and want such a call.  
(Dagdeviren, column 2, bottom, column 3, top.)

But, contrary to Dagdeviren, the combination of references, in effect, states that a video-only call (the picture of the caller) should be set up first. That is a modification of Dagdeviren.

MPEP § 2143.01, last paragraph, states:

If the proposed modification or combination of the prior art would **change the principle of operation** of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.

#### Third Problem: References Contain Contrary Teachings

A third problem is that the combination of references modifies Dagdeviren in another way. Partridge states that the visual image of the caller is received and displayed on the called party's equipment, even **before the called party "answers" the call, as by lifting the handset.** (Column 5, last full paragraph.) That is, the image of the calling party appears on the recipient's screen, **whether recipient wants that or not.**

Dagdeviren is clearly contrary. He states that his processing is only begun **after** a communication channel is voluntarily established between the parties. (Column 7, lines 37 - 39.) That

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is, the called party must "answer" the telephone first. Two-way communication is required, so that Dagdeviren's parties can ascertain that they have the proper equipment to establish a video call.

MPEP § 2145(j)(4) states:

It is improper to combine references where the references teach away from their combination.

Fourth Problem: References are Fundamentally Different

A fourth problem is that the references each implement fundamentally different approaches. In Dagdeviren, a caller initiates a digital audio call, using a video phone. Then, if the called party also has a video phone, the parties may decide to convert the digital audio call into a digital audio/video call.

Partridge, as described above, transmits a static picture even before the called party answers.

There is simply no relationship between the two references. One converts an existing digital voice call into an audio-video call. The other identifies the caller, so that the recipient can choose whether to answer the call.

Those are unrelated processes.

Fifth Problem: Elaboration of Fourth Problem

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A fifth problem is an elaboration of the fourth.

-- CASE 1. Assume that Partridge's recipient does not like the picture of the caller, and refuses to answer the telephone. In such a case, no audio call is established, so no conversion into an audio-video call, as in Dagdeviren, is possible. The references cannot be combined: there is no call to convert.

-- CASE 2. Even if Partridge's recipient DOES answer the call, Dagdeviren's apparatus cannot be used. The reason ? Partridge utilizes POTS calls. (Column 1, lines 12 - 13: "standard telephone networks" are used.) Dagdeviren switches from a digital audio call to a digital audio-video call.

The references cannot be combined.

Sixth Problem: References are Contradictory

A sixth problem is that the references are contradictory. In Dagdeviren, the parties convert a digital audio call into a digital audio-video call, if they determine that they both have compatible equipment, and if they want to. That conversion process has no applicability to Partridge. The primary reason is that Partridge

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**assumes** that the recipient has a video system which can accept his picture. There is no reason to hold an audio call, to ask the recipient if he/she has the required equipment.

Stated another way, Partridge identifies a caller to a recipient through a picture, to allow the recipient to accept or reject the caller. Dagdeviren is only used **after** the recipient has accepted the caller.

-- If Partridge's recipient **rejects** the caller, then Dagdeviren's device cannot be used, even if it were combined with Partridge. No call exists to convert.

-- If Partridge's recipient **accepts** the caller, an audio-video call has been automatically established. Dagdeviren's approach is then irrelevant.

The references take contradictory approaches, and cannot be combined.

#### Seventh Problem: Combination is Impossible

A seventh problem is that it is not possible to combine the two references. How does the video phone of Dagdeviren accept a static picture without a person lifting the handset, that is, without the video phone going off-hook ? It is not possible.

If Partridge's device is substituted into Dagdeviren, to allow

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this, then Dagdeviren is thereby rendered inoperative. MPEP § 2143.01, section 5, states:

The proposed modification cannot render the prior art unsatisfactory for its intended purpose.

Eighth Problem: Combination Achieves Nothing

An eighth problem is that the combination of references actually achieves nothing, and is completely unworkable. Dagdeviren is based on the premise that the called party does not necessarily have a video phone. If the parties find out that both of them do, in fact, have video phones, then they can switch to a video conference. (Column 1, lines 35 - 64.) But Partridge's approach cannot be used if Dagdeviren's recipient lacks a video phone.

That is, Dagdeviren can complete the digital audio call, if the recipient lacks a video phone, but the parties cannot convert that into a video call. However, Partridge cannot operate if the recipient lacks a video phone.

Thus, nothing useful is attained by combining the references. If you give the recipient a video phone, as Partridge requires, then the need for Dagdeviren evaporates. Dagdeviren is based on the premise that the recipient **may not** have a video phone.

Nothing useful is obtained by the combination of references.

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The combination of references is made by a person skilled-in-the-art, seeking to obtain something useful. If nothing useful is attained, no combination is made.

Therefore, for at least the preceding reasons, Applicant submits that the combination of references is faulty.

Even if References are Combined, (1) Claims not Obtained or  
(2) Contrary Teachings are Combined

Claim 1 recites:

1. A method of establishing an audio-video conference, comprising the following steps:
  - a) holding an audio-only conference;
  - b) displaying static visual images during the audio-only conference; and
  - c) holding an audio conference accompanied by a live video conference.

CLAIM NOT ATTAINED

The preamble recites a **single** conference. Claim 1(b) recites displaying "static video images," which is plural. (Two or more parties are involved, so plural images are displayed, one for each person.)

Partridge does not show multiple static images, in connection with a single conference. He only shows the picture of the **single** caller.

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MPEP 2143.03 states:

To establish prima facie obviousness . . . all the claim limitations must be taught or suggested by the prior art.

The multiple static images are not found in Partridge.

#### CONTRARY TEACHINGS

Partridge states that a sequence of static images is transmitted to the recipient, after the recipient answers the call. (Column 6, lines 11 - 13.) Applicant points out that, even if this is considered "video," which Applicant does not admit, this is one-way imaging. The recipient can see the caller, but the caller cannot see the recipient.

Therefore, this teaching is contrary to that of Dagdeviren, who allows the parties to elect to establish a two-way video conference.

Restated, where is the teaching to overcome Partridge's maintenance of a one-way image stream, and replace it with Dagdeviren's two-way video ?

As the MPEP section cited above states, contrary references cannot be combined.

#### Additional Point

Even if the references are combined, they require a specific

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mode of operation of Dagdeviren. As explained above, Dagdeviren does not necessarily culminate in a two-way audio-video conference. It only occurs if (1) both parties have the correct equipment and (2) they elect the conference.

Thus, even if the references are combined, claim 1(c) (the video conference) is not necessarily found. It is only found if Dagdeviren operates in a certain way.

No teaching has been shown for operating Dagdeviren in this way.

In this connection, Applicant would like to point out a distinction. Under section 102, this lack of teaching may not be relevant. [An exception is found in doctrines such as "accidental anticipations." "Accidental anticipations" are those which occur only under unusual circumstances, and do not constitute anticipations under section 102. (See Law of Patents, by D. Chisum, §§ 3.03 and 3.03(2).)]

Restated, under section 102, if a claim recites A, B, and C, and if a reference shows A, B, and sometimes C, then the reference may, possibly, anticipate the claim.

However, the present rejection is not under section 102, but under 103. Thus, in order to combine the elected video conference of Dagdeviren with Partridge, the PTO must show a teaching of why that conference occurs.

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The preceding applies to the other claims in this group.

**CONCLUSION**

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
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